

col



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,381	04/05/2000	Michael C. Chen	KTI-001	7208
5073	7590	10/11/2005	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			NGUYEN, STEVEN H D	
			ART UNIT	PAPER NUMBER
			2665	

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/543,381	Applicant(s) CHEN ET AL.	
	Examiner Steven HD Nguyen	Art Unit 2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 7/14/05
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16,18,20-24,28-41,50,51 and 53-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16,18,20-24,28-41,50,51 and 55-62 is/are rejected.
- 7) ☒ Claim(s) 53 and 54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed on 7/14/05. Claims 1-15, 17, 19, 25-27, 42-49 and 52 have been canceled and claims 16, 18, 20-24, 28-41, 50-51 and 53-62 are pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 16, 18, 22-23, 55-59 and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Vaziri (USP 6377570).

Regarding claim 16, Vaziri discloses a method for establishing voice communication between a first station and a second station, the method comprising the steps of receiving a code from a first station at a second station (Col. 17, lines 40-42, ISB stored the information of the other information ISB such serial number and telephone number etc), wherein the code uniquely identifies the first station (Col. 13, lines 34-47, telephone number); establishing a communication channel between the first station and a data network having a network server, the network server assigning a data network address to the first station (Fig 5, Ref 508 discloses the first station connects to the ISP which assigns an IP address to the ISB); identifying, at the second station,

Art Unit: 2665

the data network address of the first station based at least in part upon the code (Fig 5, Ref 516 or Fig 9a, ref 9A04, 9A10, 9A12, 9A14 and 9A16; the caller B uses the telephone number to obtain the IP address); storing the code and the data network address into a memory (Fig 5, Ref 516 or Fig 5, Ref 516 OR Fig 9a, ref 9A04, 9A10, 9A12, 9A14 and 9A16; ISBSS stores telephone number and IP address of the first station); retrieving, at the second station, the data network address of the first station by searching the memory for the code (Fig 9a, 9A10); determining whether the first and second stations can support a communication channel for voice communication over the data network (Fig 9, 9A12 discloses if a match occurs during the search; then both ISBs supports voice over data network); and establishing a communication channel between the first station and the second station for voice communication over the data network, using the data network address of said first station; if the first and second stations can support a communication channel for voice communication over the data network (Fig 9A, Ref 9A18 establish a communication between the stations using the retrieved IP address).

Regarding claim 18, Vaziri inherently discloses determining whether the code is invalid; and disconnecting the communication channel between the first station and the data network if the code is invalid (after established the communication channel, the user of first station said wrong number, then the system will disconnect the communication channel after the first station hang-up).

Regarding claims 22-23, Vaziri discloses the first station connects to the data network automatically in response to a single activation means being a programmable button depression serial (Fig 8, Ref 816C).

Regarding claim 55, Claim 55 is similar to claims 16 and 18. Therefore, claim 55 is rejected with the same rationale as claims 16 and 18.

Regarding claim 56, Claim 56 is similar to claim 16. Therefore, claim 56 is rejected with the same rationale as claim 16.

Regarding claims 57 and 59, Vaziri discloses determining whether the first and second stations have established a communication channel over the data network (Col. 4, lines 18-41); and if it is determined that the first and second stations have not established a communication channel over the data network, then establishing communication channel between said first and second stations using a circuit switched network (Col. 4, lines 41-52).

Regarding claim 58, Claim 58 is similar to claim 16. Therefore, claim 58 is rejected with the same rationale as claim 16.

Regarding claim 61, Claim 61 is similar to claims 16 and 57 or 59. Therefore, claim 65 is rejected with the same rationale as claims 16 and 57 or 59.

4. Claim 28 is rejected under 35 U.S.C. 102(e) as being anticipated by Menard (USP 6944151).

Regarding claim 28, Menard discloses a method for establishing voice communication between a first station and a second station using data and circuit switched networks, wherein the second station is not linked to the data network by determining whether to establish a communication channel for voice communication over the circuit switched network (Fig 5, Ref 306); and if so, then establishing a telephonic connection between the first and second stations over the circuit switched network if it is determined that the communication channel should be established over the circuit switched network (Fig 5, Ref 308), else triggering a single activation

Art Unit: 2665

means wherein the first station automatically establishes a communication channel between the first and second stations for voice communication over the data and circuit switched networks (Fig 5, Ref 320, 322 and 324 search for gateway in area of the dialed number and for the dialed telephone number to the gateway which dials the destination via PSTN for establishing a communication channel via packet network and PSTN).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 20-21, 24, 60 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaziri in view of Yahiro (USP 6430178).

Regarding claim 20, Vaziri discloses determining whether the first and second stations have established a communication channel over the data network (Col. 4, lines 18-41); and if it is determined that the first and second stations have not established a communication channel over the data network, then establishing communication channel between said first and second stations using a circuit switched network (Col. 4, lines 41-52). However, Vaziri fails to disclose a step of automatically establishing communication channel between said first and second stations using a circuit switched network. In the same field of endeavor, Yahiro discloses determining whether the first and second stations have established a communication channel over the data network (Fig 3); and if it is determined that the first and second stations have not

Art Unit: 2665

established a communication channel over the data network, then automatically establishing communication channel between said first and second stations using a circuit switched network (Fig 4 or 5, after determining if the communication channel via internet can not be established, then automatically switch to the ISDN network for establishing a call).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method of automatic establishing a call via ISDN network if the communication channel via internet can not be established as disclosed by Yahiro into the system of Vaziri. The motivation would have been to provide a backup channel for the system.

Regarding claims 21, 60 and 62, Vaziri and Yahiro fails to disclose selecting a service provider for the communication channel from a provider list associated with the first station. However, the examiner takes an official notice that a method and system for selecting a provider for establishing a communication channel via PSTN from a list of providers that associated with the first station is well known and expected in the art of the time of invention was made. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply this well known method into the system of Vaziri and Yahiro in order to save the cost of the long distance call for the first station by using a prefixed to select a provider.

Regarding claim 24, Vaziri and Yahiro fail disclose the single activation means is a voice signal. However, the examiner take an official notice that a method and system for using voice signal as a command signal as a request signal is well known and expected in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was

Art Unit: 2665

made to apply this well known method into the system of Vaziri and Yahiro in order to provide another feature to activate the system for customer.

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Menard.

Regarding claim 29, Menard fails to disclose establishing the communication channel between the first station and the second station over the circuit switched network further comprises the step of selecting a service provider for the communication channel from a provider list associated with the first station. However, the examiner takes an official notice that a method and system for selecting a provider for establishing a communication channel via PSTN from a list of providers that associated with the first station is well known and expected in the art of the time of invention was made. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply this well known method into the system of Menard in order to save the cost of the long distance call for the first station by using a prefixed to select a provider.

8. Claims 30-41 and are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (WO 9811704) in view of Vaziri (USP 6377570).

Regarding claims 30-31 and 37, Gordon discloses a first station for initiating voice communication with a second station over a first network and a second network, the first station being a telephonic device comprising a storage medium having stored therein a plurality of programming modules including a code module and a call initialization module (Fig 2a), wherein the call initialization module is operable to initiate a call to a second station over a first network (Fig 5b, Ref 436 or 438); and a single activation means for causing the code module to transmit a code identifying the first station when the single activation means has been activated, the code

Art Unit: 2665

routing over the first network (Fig 5b, Ref 442, the telephone number of the first station route to the second station) and if said single activation means has not been activated, the communication channel being established between the first and second stations over the first network, wherein the first network comprises a circuit switched network (Fig 5b, Ref 436). However, Gordon fails to disclose the call initialization module of the second station is operable to transmit an establish communication channel command which causes a communication channel to be established between the first and second stations over a second network based at least in part on the code. In the same field of endeavor, Vaziri discloses the call initialization module of the second station is operable to transmit an establish communication channel command which causes a communication channel to be established between the first and second stations over a second network based at least in part on the code which identifies the first station (Fig 9A, the second station retrieves IP address of the first station and establishes a communication channel to the first station).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for allowing the second station to retrieve an IP address of the first station and using it to establish a communication between them as disclosed by Vaziri into Gordon. The motivation would have been to prevent loss call.

Regarding claim 32, Gordon discloses the storage medium further comprises a response module (Fig 5a, Ref 446), the response module receiving a response signal from the second station wherein the call initialization module of the first station is operable transmit an establish communication channel command for enabling a communication channel to be established between the first and second stations over the second network in response to the response

Art Unit: 2665

module receiving the response signal (Fig 5a, Ref 122') and Vaziri discloses the storage medium further comprises a response module (Fig 5, Ref 506), the response module receiving a response signal from the second station wherein the call initialization module of the first station is operable transmit an establish communication channel command for enabling a communication channel to be established between the first and second stations over the second network in response to the response module receiving the response signal (Fig 5, Ref 508).

Regarding claim 33, Gordon disclose wherein the first network includes a data network and an IP gateway providing access to the circuit switched network serving the second station (Fig 1, Ref 44 is data network and Ref 30) and Vaziri discloses internet and gateway (Fig 7c).

Regarding claim 34, Gordon discloses a compatibility module for determining whether the second station supports a communication channel for voice communication over the second network, the compatibility module having a signaling unit (Fig 5a, Ref 110) and a detector unit (Fig 5a, Ref 112) and Vaziri discloses a signaling unit and detector unit (Fig 8, Ref 822C for using to send a tone and detect the tone and convert the tone to analog signal).

Regarding claim 35, Vaziri discloses a network selection module for establishing a communication link with the second station if it is determined the communication channel is not established over the second network, said communication link to be established over the circuit switched network (Col. 4, lines 19-52).

Regarding claim 36, Gordon and Vaziri fail to disclose communication link is established based on a provider list associated with said network selection module. However, the examiner takes an official notice that a method and system for selecting a provider for establishing a communication channel via PSTN from a list of providers that associated with the first station is

Art Unit: 2665

well known and expected in the art of the time of invention was made. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply this well known method into the system of Gordon and Vaziri in order to save the cost of the long distance call for the first station by using a prefixed to select a provider.

Regarding claims 38-39 and 41, Vaziri discloses a user interface unit located at the first station is a visual display, the user interface unit for indicating and selecting a calling feature option which said first station performs and accesses a network server for modifying the calling feature option which the first station performs (Col. 7, lines 40-47, the user interface uses for selecting calling feature via PSTN then internet or prearrange their internet call such meet me).

Regarding claim 40, Gordon and Vaziri fail to disclose the user interface is an interactive voice response application. However, the examiner takes an official notice that IVR is well known and expected in the art at the time of invention was made. Therefore, it would have been obvious to one of ordinary skill in the art to apply IVR into the teaching of Gordon and Vaziri which suggests a voice prompt in order to provide another feature to activate the system for customer.

9. Claims 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weingarten (USP 6078579) in view of Maroulis (USP 6584094).

Regarding claims 50-51, Weingarten discloses a method for establishing voice communication between a first station and a second station using a first network and a second network, the method comprising the steps of receiving a data network address for a first station at a second station via a first communication channel in a first network, the data network address identifying the first station (Col. 7, lines 25-30); initiating a second communication channel over

Art Unit: 2665

the second network between the first station and the second station for voice communication, based on at least the data network address received at the second station (Col. 7, lines 30-62), determining whether the first station and the second station have established the second communication channel over the second network; and establishing a third communication channel between the first station and the second station using a circuit switched network in response to determining that the first station and the second station have not established the second communication channel over the second network (Col. 7, lines 63-67). However, Weigarten fails to fully disclose determining whether the first station and the second station can support a communication channel for voice communication over the second network; disconnecting the first station and the second station from the first communication channel, in response to determining that the first station and the second station support voice communication over the second network. in the same field of endeavor, Maroulis discloses a method and system for transmitting the IP address of the first location to the second location via PSTN (Fig 2b, Ref 215); determining if both location can support voice over internet (Fig 2c, Ref 225) by the first location signaling to the second location and waiting for a response from the second location (Fig 2, Ref 215 and 226); establishing communication channel via internet (Fig 2, Ref 227 and 229).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system signaling between the first and second to determining if they support voice over IP or not as disclosed Maroulis into the system and method of Weingarten. The motivation would have been to reduce the cost for the customers.

Allowable Subject Matter

10. Claims 53-54 allowed.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Komuro (USP 6819663) discloses a method and system for exchanging IP address over PSTN and using IP address to establishing a channel via PSTN and Internet.

Begis (USP 6907034) discloses a method and system for exchanging IP address over PSTN and using IP address to establishing a channel via Internet.

Socaciu (USP 6542498) discloses a method and system for exchanging IP address over PSTN and using IP address to establishing a channel via PSTN and Internet.

Dunn (USP 6324280) discloses a method and system for exchanging IP address over PSTN and using IP address to establishing a channel via PSTN and Internet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (571) 272-3159. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2665

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'SHN', written over the printed name.

Steven HD Nguyen
Primary Examiner
Art Unit 2665
9/26/05